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1                                   RECORD OF ORAL HEARING  
2                                   UNITED STATES PATENT AND TRADEMARK OFFICE

3                                   \_\_\_\_\_  
4                                   BEFORE THE BOARD OF PATENT APPEALS  
5                                   AND INTERFERENCES

6                                   \_\_\_\_\_  
7                                   EX PARTE SHUWU WU and JAMES CRAWFORD

8                                   \_\_\_\_\_  
9                                   Appeal 2009-001204  
10                                  Application 09/810,159  
11                                  Technology Center 2400

12                                  \_\_\_\_\_  
13                                  Oral Hearing Held: April 23, 2009

14                                  \_\_\_\_\_  
15                                  Before LEE E. BARRETT, JOSEPH L. DIXON, and LANCE LEONARD  
16                                  BARRY, *Administrative Patent Judges*.  
17                                  DIXON, *Administrative Patent Judge*.

18  
19                                  APPEARANCES:

20                                  ON BEHALF OF THE APPELLANTS:

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1 The above-entitled matter came on for oral hearing on Thursday,  
2 April 23, 2009, at The U.S. Patent and Trademark Office, 600 Dulany Street,  
3 Alexandria, Virginia, before Christine L. Loeser, Notary Public.

4  
5 MR. DEVOTO: Good morning, Your Honors. My name is Rob  
6 Devoto. I am a patent attorney at Fish & Richardson. I am here today on  
7 behalf of my client, America Online.

8 I thank you for taking time out of your busy schedule to discuss this  
9 application with me today.

10 In an effort to be as expeditious as possible in proceeding, I thought  
11 maybe what would make sense would be for me to go through claim 1 as a  
12 representative claim, kind of walk through it and talk a little bit about an  
13 exemplary implementation of the specification if you don't object.

14 Looking at claim 1 --

15 JUDGE BARRETT: You wouldn't want to just jump to your  
16 arguments?

17 MR. DEVOTO: Would you like me to jump to  
18 the arguments? Would that make more sense? All right.

19 The Examiner asserts -- he's rejecting all the claims based on two  
20 references, Cook, which is his primary reference which he is then modifying  
21 based on the teachings of the secondary reference called Pow-wow.

22 The Examiner is basically asserting that Cook satisfies all of the  
23 limitations of the claims, including independent claim 1, with the exception  
24 that Cook fails to state that its text messages can be instant messages.

1           The Examiner relies on Pow-wow's teachings to remedy this  
2   deficiency of Cook's stating that it would have been obvious to modify  
3   Cook's system to handle instant messages that deal with the teachings of  
4   Pow-wow.

5           We disagree with the Examiner for various reasons. First, Cook is not  
6   -- first, the Examiner is mischaracterizing Cook in referring to Cook as  
7   describing a system that is just generic to text messaging. A person of  
8   ordinary skill in the art reviewing Cook would think these teachings are  
9   applicable to any form of text messaging.

10          It's generic. I could apply it, it's instant messaging or e-mail, you  
11   know, it's generic. But it doesn't explicitly disclose instant messaging so  
12   therefore I will rely on Pow-wow to remedy that deficiency.

13          We disagree with that. In fact, we assert that Cook is very much  
14   specific to e-mail. There are various portions in Cook that repeatedly call  
15   out the invention as being related to e-mail, to being an e-mail system that  
16   has been customized to better handle different contents of – different kinds  
17   of contents in e-mails.

18          In fact, the language in the specification or the detailed description of  
19   Cook repeatedly refers to the invention, not a preferred embodiment, but the  
20   invention as being in an e-mail system. Basically it has been modified.

21          Secondly, as you'll notice in the background section of Cook, Cook  
22   describes a main problem that is trying to be addressed by Cook's system is a  
23   problem specific to e-mail systems. That is, the e-mail systems do not  
24   recognize and distinguish between e-mails having different types of content.

1           Rather, typical e-mail systems, legacy systems, treat every e-mail as  
2           basically a single document that may or may not have attachments and have  
3           interfaces that really treat them as a single document.

4           It doesn't distinguish between an e-mail that may have an audio  
5           attachment or voice message attachment, an e-mail might have an image  
6           attachment or an e-mail that has one type of content or a different type of  
7           content.

8           JUDGE DIXON: In your briefs, you keep talking about minimizing  
9           the distinctions between e-mail and instant messaging systems but you never  
10          argue what the specific distinctions are. You just are saying there are vast  
11          distinctions between e-mail and instant messaging.

12          MR. DEVOTO: I think in some ways there is an argument of what  
13          the distinctions are. Maybe I should have been a little more direct about the  
14          distinctions. There's an argument to the extent that e-mail has a feature like  
15          a mailbox that is just inapplicable to an instant messaging system.

16          JUDGE DIXON: We don't need the mail box for claim 1.

17          MR. DEVOTO: Exactly. You don't need a mail box for an instant  
18          messaging system. So graphically user interfaces that show a mail box and  
19          lists the pieces of mail in a mail box really are inapplicable to instant  
20          messaging.

21          So for the Examiner to refer to sets of figures that really show really  
22          e-mail specific interfaces and then say, well, I would make them voice mail  
23          or, I'm sorry, instant messaging in some form or another, it struck me as very  
24          odd and I couldn't understand where he was going with that. I don't see that.  
25          They are inapplicable.

1           The Examiner, and I have talked to the Examiner over the phone as  
2 well about this, and he did not -- he could not elucidate what he was really  
3 envisioning, certainly not to arrive at the claimed limitations.

4           JUDGE DIXON: Would it be better if in the Pow-wow reference had  
5 the pictures in the reference that we could understand what method two  
6 under page Method 2 looks pretty much like the independent claim.

7           MR. DEVOTO: You are talking about the Pow-wow reference.

8           JUDGE DIXON: Method 2 on the second page.

9           MR. DEVOTO: If you look at Pow-wow reference, the voice chat  
10 method of 2 of the voice chat and I think there was some arguments back  
11 and forth and I could reiterate them with you and I think they were touched  
12 upon in the Appeal Brief. This reference here suggests that there is a  
13 personal navigator window and that there is a conditional presentation of a  
14 button on that personal navigator window -- personal communicator, sorry,  
15 personal communicator window that is conditionally presented based on  
16 whether there's more than one person connected to that personal navigator  
17 window.

18           In our claims, we have specifically required a condition precedent for  
19 the display of the graphical user interface and having the icon  
20 user selectable to invoke voice communications that the condition precedent  
21 for that display is receipt of a text instant message.

22           We have argued that this, that this personal navigator window that  
23 pops up this button when there is more than one person connected does not  
24 have as a condition precedent to the display of that button receipt of a text  
25 instant message.

1           Rather, it could very well be that it operates just like a chat room  
2     where they just simply connect up to the window. They didn't say anything,  
3     they didn't send any text message, they didn't say anything to each other. It  
4     just pops up when they connect up.

5           So there is nothing from this description that would suggest that this  
6     satisfies the independent claim language specifically with respect to the  
7     enabling of the graphical user interface that includes the message text and  
8     the icon, having a condition precedent for that presentation being received of  
9     a text instant message. I would like to make one other point. I don't think I -  
10    - maybe I didn't elaborate on it as fully in the reply brief. But I do want to  
11    make one point. If you look at Cook alone and you look at what Cook  
12    describes --

13          JUDGE BARRY: I'm sorry, counsel. You are saying you are going  
14    to make a point that was not in your briefs?

15          MR. DEVOTO: No. I am elaborating on something.

16          JUDGE BARRY: Where in the Reply Brief are you, is the original  
17    point on which you are going to elaborate?

18          MR. DEVOTO: The point is that the e-mail system is entirely  
19    different and distinct from an instant message system. You transform an e-  
20    mail system to an instant messaging system. It's a non-trivial endeavor. It is  
21    not something that you can just simply say, Yes, I have a system that is an e-  
22    mail system and it is something I am going to take it to graphical user  
23    interface and change it to instant messaging.

1 In fact, in the particular case here with Cook which repeatedly refers  
2 to its system as an e-mail system, such a transformation to an IM system, it  
3 really violates NP and EP. And I didn't say this explicitly in the response,  
4 but it violates NP and EP 2143.01, sections 5 and 6, in this sense, that it  
5 renders, 7 because the system is specifically directed to addressing a  
6 problem that has been identified as specific to e-mail systems, to change it  
7 into an IM system renders it inoperable for its intended purpose which is  
8 specific to e-mail systems, addressing a deficiency of existing e-mail  
9 systems.

10 The second it would require a drastic redesign that really is  
11 unspecified and nowhere in the art, a suggestion of such a drastic redesign.

12 JUDGE DIXON: Wouldn't it just be the graphical user interface that  
13 would be appended to or modified, as opposed to trying to modify the whole  
14 e-mail system which more, Cook shows the graphical user interface of some  
15 sort which, there is some interface in Pow-wow but we are not sure what it is  
16 because it is such a brief reference with no pictures to it and the other Pow-  
17 wow reference does discuss how it can be used for conferences and other  
18 things for clients but we are still left wondering what is the interface.

19 It should have one, some graphical user interface. The question  
20 would be, do we get the voice icon conditioned precedent on receiving the  
21 text message but doesn't it, I mean, Pow-wow seems to --

22 MR. DEVOTO: I don't think Pow-wow discloses that at all. In fact,  
23 first of all, it is interesting --



1 JUDGE DIXON: What is -- so connected through the personal  
2 communicator, you don't have to have received a text message at that point.  
3 You are just acknowledging that you are online now for people to send you  
4 something.

5 MR. DEVOTO: That's right, that's exactly right. And in fact, it's  
6 interesting because you are now focusing on Pow-wow as the primary  
7 reference and trying to fill in gaps based on -- which is fine.

8 JUDGE DIXON: It's more the way I view it. You are just trying to  
9 put a graphical user interface in an IM system as opposed to change a whole  
10 e-mail system which has a more developed graphical user interface because  
11 it is there most of the time for manipulating your mailbox and mail and stuff  
12 like that.

13 The way I look at it is we are trying to put the graphical user interface  
14 that something has to be there because otherwise you can't input and receive  
15 information in the instant messaging system. They all have graphical user  
16 interface. The question is, what does this one have.

17 MR. DEVOTO: And what that looks like --

18 JUDGE BARRY: It says you have got buttons, window button bars.  
19 So you definitely have a GUI (graphical user interface), as Judge Dixon  
20 said. Now what else, what do you want to make it look like?

21 MR. DEVOTO: Sure. I could argue that it actually does a pretty  
22 good job through text to tell you what it looks like. They envision a  
23 window. It is a personal communicator window that has a button

1 panel. And the button either appears or doesn't appear based on a certain  
2 condition precedent. What I am saying is that condition precedent in Pow-  
3 wow is not the same as what we've claimed. That's what I'm saying. So  
4 even if you were to try to flesh out the disclosure of Pow-wow by inserting  
5 some interface system you might grab from some other reference, some  
6 secondary reference, I would argue that the teachings of Pow-wow  
7 themselves fail to get to where they need to be to really fall within the scope  
8 of our claims. No other questions?

9 JUDGE BARRETT: No. Thank you.

10 MR. DEVOTO: Fantastic. Appreciate it. I'm sorry. I did want to  
11 add one other. I apologize. One other comment.

12 The Examiner has failed to address the limitations of claim 44 which  
13 are different than those of claim 1. So claim 1 is -- has similar limitations  
14 although having difference -- let me back up.

15 Claim 44 has limitations that are distinct from claim 1. I want you to  
16 be aware of that. We did argue the claim 44 as a separate claim in our  
17 Appeal Brief.

18 I want you to focus on the determining in response to receipt of the  
19 text instant message, the capabilities of the recipient to accept voice  
20 communications.

21 I do not believe that the Examiner has pointed out where this active  
22 determination step is found in the art. The Examiner has simply said the  
23 limitations are similar to all the other claims and therefore I do not need to  
24 address the specifics of it.

1           I want to point that out as well and I do not believe this is found in the  
2 art either as stated in the Appeal Brief.

3           JUDGE BARRETT: Okay. Thank you.

4           MR. DEVOTO: Thank you very much.

5           (Whereupon, the proceeding was concluded on Thursday, April 23,  
6 2009.)